

REMARKS

Applicant has carefully reviewed and considered the Office Action mailed on March 27, 2003, and the references cited therewith.

No claims are amended, canceled, or added in this response; as a result, claims 1-11, 13-18, 20 and 21 remain pending in this application.

§102 Rejection of the Claims

Claims 1-4, 13-18, 20 and 21 were explicitly rejected under 35 USC § 102(e) as being anticipated by Kikinis et al. (US 5,835,732). Claims 5-11 were not explicitly rejected in the first sentence of section 3 of the Office Action, however Kikinis was applied to claims 5-11 in section 3 of the Office Action. Applicant assumes for the purposes of this response that the Office Action intended to include claims 5-11 in the anticipation rejection.

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon* 919 F.2d 688, 16 USPQ 2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, arranged as in the claim.” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added). Applicant respectfully traverses the rejection and submits that the Office Action did not make out a *prima facie* case of anticipation because the cited reference does not disclose each and every element in Applicant’s claims.

A first example of an element not disclosed in Kikinis is found in claims 1 which recites “a connector operatively coupled to the communications link, said connector disposed within the housing...”. Claims 17 and 20 recite similar language. The Office Action asserts that connector 14’ of FIG. 6 of Kikinis is a connector disposed within the housing. Applicant respectfully disagrees with this assertion. FIG. 6 illustrates that connector 14’ is disposed on host computer 66. Further, Kikinis at column 10, lines 8-25 states that input device 60 of FIG. 6 may be a

keyboard. It is clear from this description that input device 60 is a separate element of host computer 66. FIG. 6 also clearly shows that connector 14' is not disposed within input device 60. As a result, Kikinis does not disclose that connector 14' is disposed within a housing for a keyboard, rather Kikinis illustrates that connector 14' is disposed on a host computer 66. Because Kikinis does not disclose a connector disposed within a housing for a keyboard, Kikinis does not teach each and element of Applicant's claims. Applicant therefore respectfully requests the withdrawal of the rejection of claims 1, 17 and 20.

Claim 2 depends from claim 1 and further recites that "the housing has a plurality of surfaces defining a cradle cavity into which the connector is disposed, the cradle cavity shaped so that the device fits into the cavity such that at least one surface of the device is exposed." The Office Action asserts that Kikinis at FIG. 5 discloses the recited language. Applicant respectfully disagrees with this assertion. Kikinis at FIG. 5 illustrates a notebook computer 172 having a Type II PCMCIA docking port 105. The notebook computer illustrated in FIG. 5 is not a housing for a non-integral keyboard, as recited in claim 1 and inherited by claim 2. Thus the notebook housing illustrated in FIG. 5 is different from a non-integral keyboard housing recited in Applicant's claims. Nowhere does Kikinis teach a non-integral keyboard having a plurality of surfaces defining a cradle cavity. As a result, Kikinis does not teach each and every element of claim 2. Applicant respectfully requests the withdrawal of the rejection of claim 2.

Claims 3 and 4 depend from claim 2 (and indirectly from claim 1). Claim 18 depends from claim 17. These dependent claims are therefore not anticipated for the reasons discussed above with regarding their respective base claims 1, 2 and 17. Applicant respectfully requests the withdrawal of the rejection of claims 3, 4 and 18.

Claim 5 depends from claim 2 and further recites that "at least one of a top surface and a bottom surface of the device is flush with a corresponding surface of the housing." Claim 21 depends from claim 20 and recites similar language. The Office Action asserts that the recited language is "inherited in the structure, since the device (10) is inserted in a docking bay." Applicant respectfully disagrees with this interpretation of Kikinis. If the device is inserted into a docking bay, it may be wholly surrounded by the docking bay or a portion of the device may extend outside of the docking bay. Even assuming that Kikinis disclosed a cradle cavity within a housing for a non-integral keyboard (which as argued above is not the case), it is not inherited

(nor inherent) in the structure of Kikinis that a surface of the device is flush with the surface of a keyboard housing. As a result, Kikinis does not teach or disclose each and every element of claim 5. Applicant respectfully requests the withdrawal of the rejection of claim 5 and 21.

Claims 6-11, 13, 15 and 16 depend directly or indirectly from claim 1. They are therefore not anticipated for the reasons discussed above with respect to claim 1. Applicant respectfully requests the withdrawal of the rejection of claims 6-11, 13, 15 and 16.

Claim 14 depends from claim 1 and further recites "the device is a touch screen device having at least one changeable virtual key." As defined in Applicant's specification the changeable virtual keys in effect extend the capabilities of the keyboard when the device is docked to the keyboard and that such keys are programmed in accordance with computer software applications running on the computer, and change in accordance with the active application on the computer. Thus the virtual keys of the present invention interact with the host computer. In contrast, the softkey disclosed in Kikinis does not interact with the host computer, rather it is a softkey operable on the PDA itself. As a result, Kikinis does not disclose the virtual key operation as claimed. Applicant respectfully requests the withdrawal of the rejection of claim 14.

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111

Serial Number: 08/953154

Filing Date: October 17, 1997

Title: MODULAR COMPUTER DEVICE AND COMPUTER KEYBOARD FOR MODULAR DEVICE

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Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612-373-6954) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 50-0439.


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Date June 28, 2003

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, P.O.Box 1450, Alexandria, VA 22313-1450, on this 28th day of July, 2003.

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